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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,859	02/28/2000	D. Neale BARRET	SJO000031US1	9122

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EXAMINER

CHANCE, JANET D

ART UNIT PAPER NUMBER

3626

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,859

Applicant(s)

BARRET ET AL.

Examiner

Janet D. Chance

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the response filed 28 October 2002. Claims 1-36 are pending, and claims 1-3, 7-8, 11-12, 14, 17, 25, 31 and 34 have been amended.

Drawings

2. The objection to the drawings is hereby withdrawn in view of the amendment filed 28 October 2002.

Specification

3. The objection to the specification is hereby withdrawn in view of the amendment filed 28 October 2002.

Claim Rejections - 35 USC § 101

4. The rejection to claims 25-36 under 35 USC § 101 is hereby withdrawn in view of the amendment filed 28 October 2002.

Claim Rejections - 35 USC § 112

5. The rejection of the claims under 35 USC § 112, second paragraph, is hereby withdrawn in view of the amendment filed 28 October 2002.

Claim Rejections - 35 USC § 103

6 Claims 1-3, 6-7, 10-12, 14, 17-19, 23-26, 31-33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent No. 6,161, 095) and further in view of Brown (U.S. Patent No. 6,032,119).

(A) Claim 1 has been amended to recite “including medical event information”. As per this limitation Brown (095) teaches a medication information and medical history information (Brown (095); col. 5, lines 8-23 and col. 6, lines 8-14). However, Brown (095) does not expressly disclose medical events. Brown (119) teaches the storage of medical events/symptoms (Brown (119); Figures 4-D, 5-B, 5-D). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the medical events of Brown (119) to the system of Brown (095) with the motivation of “involving patients in their own care” (Brown (119); col. 1, lines 64-65).

 Claim 1 has been further amended to recite transmitting the patient data structure “directly” between a physician computer and a portable patient device. As per this limitation Brown (095) teaches communication between the portable patient device and the physician computer via a server (Brown (095); Figure 1 and col. 4, lines 45-55) and the communication between the patient device and the portable patient device each of which could be a desktop or hand held computing device using direct infrared, radio, or docking connection (Brown (095); col. 4, lines 52-56). Brown (095) does not expressly disclose the direct communication for use between the physician and the patient devices. However, direct communication between computer and hand held devices was common practice at the time of the invention. It would

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have been obvious to one of ordinary skill at the time of the invention to duplicate the direct communications used between the patient devices for use between the physician and patient devices with the motivation of “reducing the time and expense required for medical personnel to individually monitor, evaluate and modify treatment regimens” (Brown (095); col. 2, lines 23-26) and as established in *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 6) and incorporated herein.

(B) Claims 2 and 7 have been amended to recite “a” patent medication “schedule view” and “an” appointment schedule “view”. As per these limitations Brown (095) teaches a portable patient device displaying patient medical information (Brown (095); col. 5, lines 4-23).

However, Brown (095) does not expressly disclose the display of a medication schedule view.

Brown (119) teaches the display of a medication schedule view (Brown (119); col. 6, lines 35-41 and Figures 5A-5B and 5D). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the medication schedule view of Brown (119) to the medical information display of Brown (095) with the motivation of “communicating health information between health providers and patients” (Brown (119); col. 1, lines 48-50).

(C) Claim 3 has been amended to recite “shown in the patient medication schedule view” and the scheduled “patient” medication. As per these limitations Brown (095) teaches a portable patient device displaying patient medical information (Brown (095); col. 5, lines 4-23).

However, Brown (095) does not expressly disclose the display of a medication schedule view.

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Brown (119) teaches the display of a medication schedule view (Brown (119); col. 6, lines 35-41 and Figures 5A-5B and 5D). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the medication schedule view of Brown (119) to the medical information display of Brown (095) with the motivation of “communicating health information between health providers and patients” (Brown (119); col. 1, lines 48-50).

(D) Claims 6, 10, 12, 18-19, 23-24, 26, 32-33, and 36 have not been amended and are rejected for the same reasons provided in the prior office Action (Paper number 6), and incorporated herein.

(E) Claims 11, 17, 25, and 31 have been amended to recite medical history information “including medical event information”, transmitting the patient data structure “directly” to the portable patient device and receiving the patient data structure “directly” from the portable patient device. As to these limitations, Brown (095) teaches a medication information and medical history information (Brown (095); col. 5, lines 8-23 and col. 6, lines 8-14). However, Brown (095) does not expressly disclose medical events. Brown (119) teaches the storage of medical events/symptoms (Brown (119); Figures 4-D, 5-B, 5-D). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the medical events of Brown (119) to the system of Brown (095) with the motivation of “involving patients in their own care” (Brown (119); col. 1, lines 64-65). As per the recitation of “directly” Brown (095) teaches communication between the portable patient device and the physician computer via a server (Brown (095); Figure 1 and col. 4, lines 45-55) and the communication between the patient

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device and portable patient device each of which could be a desktop or hand held computing device using direct infrared, radio or docking connection (Brown (095); col. 4, lines 52-56). Brown (095) does not expressly disclose the direct communication for use between the physician and the patient devices. It would have been obvious to one of ordinary skill at the time of the invention to duplicate the direct communications used between the patient devices for use between the physician and patient devices with the motivation of "reducing the time and expense required for medical personnel to individually monitor, evaluate and modify treatment regimens" (Brown (095); col. 2, lines 23-26) and as established in *In re Harza*, 124 USPQ 378, 380; 274 F.2d 669 (CCPA 1960).

The remainder of claims 11, 17, and 25 are rejected for the same reasons given in the prior Office Action (paper number 6) for those claims and incorporated herein.

(F) Claim 14 has been amended to remove "at" after "scheduled medical visit". However, this change does not affect the scope and/or breadth of the claim as originally presented and/or the manner in which the claims were interpreted by the Examiner when applying prior art in the previous Office Action (paper number 6). As such the claim is rejected for the same reasons provided in the prior Office Action (paper number 6), and incorporated herein.

7. Claims 4, 20 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (095), and Brown (119) as applied to claims 1, 17, and 31 above, and further in view of Rose (U.S. Patent No. 4,695,954).

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(A) Claims 4 and 20 have not been amended and therefore are rejected for the same reasons provided in the prior Office Action (paper number 6) and incorporated herein.

(B) Claim 34 has been amended to recite setting an alarm to activate to "provide an" alert. However, this change does not affect the scope and/or breadth of the claim as originally presented and/or the manner in which the claims were interpreted by the Examiner when applying prior art in the previous Office Action (paper number 6). As such the claim is rejected for the same reasons provided in the prior Office Action (paper number 6), and incorporated herein.

8. Claims 5, 9, 13, 16, 21-22, 27-28, 30, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (095), and Brown (119) as applied to claims 1, 11-12, 17, 25-26 and 31 above, and further in view of Ballantyne (U.S. Patent No. 5,867,821).

(A) Claims 5, 9, 13, 16, 21-22, 27-28, 30, and 35 have not been amended and therefore are rejected for the same reasons provided in the prior Office Action (paper number 6) and incorporated herein.

9. Claims 8, 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (095), and Brown (119) as applied to claims 1, 6-7, 11 and 25 above, and further in view of Evans (U.S. Patent No. 5,924,074).

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(A) Claim 8 has been amended to include the recitation of patient appointments from “the” appointment schedule “view”. However, this change does not affect the scope and/or breadth of the claim as originally presented and/or the manner in which the claims were interpreted by the Examiner when applying prior art in the previous Office Action (paper number 6). As such the claim is rejected for the same reasons provided in the prior Office Action (paper number 6), and incorporated herein.

(B) Claims 15 and 29 have not been amended and therefore are rejected for the same reasons provided in the prior Office Action (paper number 6), and incorporated herein.

Responses to Arguments

10. Applicant’s arguments filed 28 October 2002 have been considered but are not persuasive. They will be addressed in the order of their appearance in the amendment.

(A) As per Applicants arguments on pages 14-16 regarding amended claim 1 that Brown (095) does not teach or suggest Applicant’s limitations, the Examiner respectfully disagrees.

One cannot show non-obviousness by attacking references individually where the rejections are based on a combination of references nor is the test for obviousness based on what is expressly stated in any one of the references. Rather, the test is what the combined teachings would have suggested to those of ordinary skill in the art. See *in re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

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As per the argument that Brown (095) does not teach the patient data structure, that all the information is stored together in the patient data structure, the inclusion of medical events in the data structure, or the direct communication, it is respectfully submitted that the combination of Brown (095) and Brown (119) references expressly teach or suggest the use of, and the transmission from physician to patient, of all the data in claim 1. Therefore all of the limitations which Applicant disputes as missing, including the newly added features in the amendment of 28 October 2002, have been addressed in view of the collective expressed teachings of Brown (095), and Brown (119) and by what they would obviously suggest to one of ordinary skill in the art at the time of the invention as detailed in the explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 6), and incorporated herein.

With regard to the argument that Brown (095) does not suggest the data structure being modified, it is respectfully submitted that the applicant has misinterpreted the art. Brown (095) clearly states in several citations that the data structure is modified such as in Brown (095); col. 7, lines 29-31.

With regard to applicant's argument that the Brown (119) reference to a logbook teaches away from the data structure, again Examiner respectfully submits that the applicant has misinterpreted the art. The cited "logbook" of Brown (119) is referring to a portion of software in the patient device as shown by the Figures 4D and thus is included in the patient data structure as claimed by the applicant.

(B) Similar arguments can be applied to independent claims 11, 17, 25 and 31.

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With regard to the argument of claim 11 that the use of the server in Brown (095) teaches away from the direct communication of the instant application, the Examiner respectfully submits that the Applicant is looking at the specific structure of the communication between the physician and patient device in a vacuum. Brown (095) clearly uses computer to handheld device communication as cited in section 6A of this Office Action prior to sending the information to the network, as such, it would have been obvious to one of ordinary skill at the time of the invention to use the direct communication method for the physician to patient communications. Brown (095) does not discuss the downfalls of this communication method or why it should not be used in the reference for communication between patient and physician. Therefore, Brown (095) does not teach away.

With regard to the argument of claim 31 that Brown (095) does not teach storage of the data structure in the patient device, the Examiner respectfully disagrees. Transmitting of the patient data structure to the patient device was already described in the rejection of claim 1, which was the basis for the rejection of claim 31. Therefore, the rejection of claim 31 used further citations showing the patient device to have capability to store the patient data structure that was transmitted to it as cited in claim 1.

(C) With regard to the dependent claims 2-3, 6-7, 10, 12, 14, 18-19, 23-24, 26, 31-33, and 36 have not been separately argued, and therefore, inherit the non-persuasive arguments of their respective independent claims.

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(D) The arguments about claims 4, 20 and 34 merely restate the argument that Brown (095) does not teach the data structure, which has been addressed above.

(E) As per the arguments regarding Ballantyne and the data structure, logging information, billing information, and appointment information on pages 19-21, it is respectfully submitted that Ballantyne was not used in the capacity of data structure and this argument was addressed in preceding sections on this Office action. Therefore the argument, that Ballantyne cannot add other information since the reference did not teach the data structure, is not persuasive.

As per the argument that the Ballantyne reference teaches away from the invention by logging an access time and name of each user, the Examiner respectfully disagrees. Ballantyne teaches the use of a log to provide a complete audit trail of all modifications to the patient data structure as detailed in the prior Office Action (paper number 6). Further Ballantyne teaches the one to one relationship between medical personnel ID and the handheld unit ID. This information plus the time and date stamp of all changes, and the log of all users who access the file show the audit trail of who made what changes (Ballantyne; col. 15, line 15-40). Also Ballantyne determines when changes are made, sends changes to the medical professional, and requires an acknowledgement of the changes from the medical professional (Ballantyne; col. 13, lines 30-40). Therefore, Ballantyne clearly teaches logging information indicating changes to the data.

As per the argument that Ballantyne does not teach the log file being “read-only”, Ballantyne teaches different users having differing access levels to the system. One of ordinary skill in the art would be able to easily create a “read-only” access level, as this is common

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practice, especially with regard to audit trail information. Audit information would not be valuable as audit information, if it could be modified. It is respectfully submitted that Applicant underestimates the skill on one of ordinary skill in the art in this regard, nor did the applicant invent read-only access to a log file.

(F) As per the arguments regarding Evans on pages 21-22 and teaching the claimed data structure, it is respectfully submitted that Evans was not used in this capacity and this argument has been addressed in preceding sections of this Office Action. Therefore the argument that Evans cannot add other information since the reference did not teach the data structure is not persuasive.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon art teaches a data collection system in which data is transmitted directly from the remote device to a physician's computer (2002/0181680 A1) and a system in which there are wireless communication paths between a PC and a PDA (6,034,621).

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

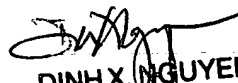
(703) 305-7687 [Official communications]

(703) 746-7238 [After Final communications, labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

jdc

January 6, 2003


DINH X. NGUYEN
PRIMARY EXAMINER